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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,025	09/01/2000	Mark L. Yoseloff	PA0463.ap.US	5837

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Mark A Litman & Associates P A
3209 West 76th Street
York Business Center
Suite 205
Edina, MN 55435

EXAMINER	
WHITE, CARMEN D	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 09/654,025	Applicant(s) YOSELOFF ET AL.	
	Examiner Carmen D. White	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 October 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Respons to Amendment

The amendment to the claims filed on October 19, 2002 does not fully comply with the requirements of 37 CFR 1.121(c)(1)(i)- see below- because the clean copy still contains a few underlines and parentheses. It appears that Applicant attempted to submit a clean copy. Therefore, it has been entered for the purposes of an office action. However, the examiner requests a totally clean copy for the record for purposes of clarity.

Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

> (c) Claims.
> (1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.
> (i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-11 recite the limitation "the same game event" in line 11 of claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Bennett*** (6,251,013) in view of ***Schultz*** (5,332,228).

Regarding claims 1-17 and 19-21, Bennett teaches a video wagering game in which the player places a wager on a reel-slot type video game having a plurality of symbol positions; displaying a plurality of randomly selected game symbols on a display, each symbol appearing in a designated symbol position; upon the occurrence of a predetermined triggering event, randomly selecting a maximum number of viewable symbol positions as a wild symbol position (col. 1, lines 55-67; col. 2, lines 33-38); converting each symbol displayed within each selected wild symbol position to a wild symbol; and determining game outcomes based on the displayed game symbols and wild symbols (abstract; Fig. 4 and Fig. 5; col. 2, lines 54-67). While Bennett teaches that a triggering event causes certain symbol positions to turn to wild symbol positions (see col. 2, lines 33-38, in which a the symbol positions within a row are turned to wild symbol positions), Bennett is silent regarding the explicit disclosure of the selection of between zero and *fewer than a maximum number* of symbol positions and the feature of

determining the outcome of the game based on the game symbols and the wild symbols *within the same game event*. However, in an analogous game that includes wild symbol positions, Schultz teaches a slot video game that better emphasizes these features (abstract; col. 3, lines 62-67; col. 7, lines 28-36). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ these features taught by Schultz in Bennett to make the game more interesting and to increase the odds of the player obtaining additional winnings than originally expected.

Regarding claim 18, Bennett and Schultz teach all the limitations of the claims as discussed above. As discussed in the initial office action, Bennett does not explicitly state the features of this claim limitation. However, the examiner noted that it would have been obvious to include this in Bennett. Further, in light of the amendment to the above independent claims, the examiner has cited the Schultz reference. The Schultz reference teaches the feature of simultaneously including the outcome of the regular symbol game and the symbol game including the wild symbols (col. 7, lines 19-36). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Schultz in Bennett to increase the player's winnings.

Examiner's Response to Applicant's Remarks

Applicant argues that Bennett teaches the selection of symbols and not symbol positions as taught by the instant claimed invention. The examiner disagrees. Bennett also teaches the feature of the selection of symbol positions (see col. 2, lines 33-38). Further Applicant argues that Bennett does not teach the features of the newly amended claim limitations of "in the same game event" and "selecting between zero and

fewer than a maximum number of symbol positions..." The examiner has cited the Schultz reference, which has a similar game feature as Bennett in a card game embodiment in which not all of the symbol positions (a maximum number) are changed to wild symbols. Further, Schultz clearly teaches that this is all done in a single card game. Schultz also provides additional clarity that symbol positions are chosen and not symbols.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-

5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

C. White
Patent Examiner

Joe H. Cheng
Primary Examiner